

59



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,386	09/18/2003	Michael C. Withiam	03-203	7517
7590	03/23/2006			
Carlos Nieves, Esq. J. M. Huber Corporation 333 Thornall Street Edison, NJ 08837-2220				
EXAMINER OH, SIMON J				
ART UNIT		PAPER NUMBER		
1618				

DATE MAILED: 03/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/666,386

Applicant(s)

WITHIAM ET AL.

Examiner

Simon J. Oh

Art Unit

1618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 12, the applicant recites a minimum amount of component (a) at about 0.5% by weight. However, the applicant then recites a maximum amount of component (b) of about 99% by weight. Such a maximum proportion cannot coexist with the stated minimum of component (a). The applicant is requested to clarify this discrepancy.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 and 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suffis *et al.* (U.S. Patent No. 5,378,468)

The Suffis *et al.* patent teaches cosmetic compositions that may be formulated as a deodorant in various forms, such as gelled sticks, sprays, aerosols, roll-ons, lotions and creams

Art Unit: 1618

(See Column 3, Lines 28-62). The composition is described as having an alkaline pH (See Abstract). The composition may further comprise alkali earth metal silicates (See Column 6, Lines 6-28). Additional components such as fragrances, water, propylene glycol, and coloring agents may also be included (See Column 12, Line 67 to Column 13, Line 37).

Although the prior art is silent with respect to oil absorption properties, it is the position of the examiner that these limitations have been made obvious by the prior art, as it has disclosed the same metal silicates as those recited in the instant claims. Since a material cannot stand apart from its properties, it is the position of the examiner that such claim limitations do not impart patentability to the instant claims. Similarly, the prior art has generally disclosed that the disclosed compositions have an alkaline pH. The examiner shifts the burden onto the applicant to show what unexpected result arises from the selection of a particular pH between 9 and 10. As such, the instantly claimed invention is *prima facie* obvious.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suffis *et al.* in view of Kuroda *et al.* (U.S. Patent No. 6,132,743)

The relevant portions of the Suffis *et al.* reference are detailed in the above rejection of Claims 1-5 and 7-11 under 35 U.S.C. 103(a).

The Suffis *et al.* patent is silent with respect to particle size.

The Kuroda *et al.* patent teaches the use of a zinc oxide powder having a particle size from between 5 nm to 20 μ m (See Column 3, Lines 25-44). This powder may be used in cosmetic preparations such as deodorants (See Column 9, Lines 26-36).

Art Unit: 1618

It would be obvious to one of ordinary skill in the art to combine the two prior art references in order to arrive at the invention of Claim 6. As both references disclose metal oxide powders for use in cosmetics such as deodorants, they are considered to be analogous to each other. Thus, one of ordinary skill in the art would be motivated to combine the references in order to find guidance as to an appropriate particle size at which to use the alkali earth metal silicate powders disclosed in Suffis *et al.* As the references are analogous to each other, one of ordinary skill in the art would have a reasonable expectation of success in combining the references. Thus, the instantly claimed invention is prima facie obvious.

Art Unit: 1618

Correspondence

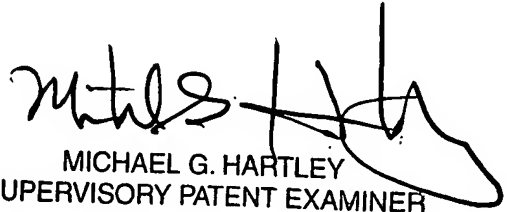
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Simon J. Oh whose telephone number is (571) 272-0599. The examiner can normally be reached on M-F 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Simon J. Oh
Examiner
Art Unit 1618

sj0


MICHAEL G. HARTLEY
SUPERVISORY PATENT EXAMINER